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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,471	10/31/2005	Zino Lee	1508-7 PCT/US	4067
23869 7590 12/24/2009 HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791				
EXAMINER				
ZURITA, JAMES II				
ART UNIT		PAPER NUMBER		
3625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/555,471

**Applicant(s)**

LEE, ZINO

**Examiner**

JAMES ZURITA

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date 10/31/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

The instant application is a national stage entry of PCT/KR04/01013, International Filing Date of 04/30/2004, which claims foreign priority to 10-2003-0027938, filed 05/01/2003. The application was published on 11/11/2004 as WO 2004097662A1.

### ***Information Disclosure Statement***

The information disclosure statement filed 10/31/2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

The IDS mentions application KR20-301693Y, filed 01/08/03 in Korea. Applicant has not provided an English translation of this document.

### ***Claim Objections***

Claims 1-9 are objected to because of the following informalities:

The claims refer to first level, second level, third level and fourth level.

The figures refer to level 0, level 1, level 2 and level 3.

Claim 6 reads, in part, "...[providing a return path management system]  
...determined to be delivered to the provider system belonging to a first level, the  
**[which?]** system identifies..." It is not clear which system is being referred to.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 6 and 7 contain the term or **[if statements]** and "...depending on..." The term renders the claims indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the or. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met.

Claims 1-9 refer to user authentication. The disclosures also refer to user authentication but do not elaborate as to what constitutes user authentication.

Claims 1-9 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. At times, it is not

possible to determine the metes and bounds of the claims, and what is specifically being claimed. For example, claim 2 and 7 refer to ...a billing processing...and...a billing processing information...

...perform a billing processing...delivers a user authentication information and a billing processing information in combination with the received order information to the provider system in a packetized form, and updates the content database referring to contents received from the provider system...

Claims 2, 5, 7 and 9 refer to update[...] content database, and it is not clear what is being updated, and when the updating takes place:

...updates the content database referring to contents received from the provider system. (claims 2 and 7)  
...an update of contents is performed referring to the content database (claims 5 and 9).

Claims 1-4 and 6-8 refer to delivering/communicating order information in packet[...], encapsulated packet and packetized form to provider. Fig. shows that service level, destination URL, user authentication information, billing processing information, other order information and application-related information are not part of the encapsulated packet.

Claims 1-9 refer to ordering, order information. The disclosures refer to delivery of goods and services, and show that order acknowledgement information is sent from reference 600 to a user. Thus, there is no delivery shown for any goods ordered. The disclosures support delivery of digital goods, not physical goods.

Claims 1-9 refer to **packet**[...] as follows:

communication packetization, Claims 1 and 6  
communication packet, claim 3, four times  
encapsulated packet of the order information, claim 3, three times  
packetized form, claims 1, 2 and 7

It is not clear what is contained in a packet, and what Applicant considers an encapsulated packet. Thus, it is not possible to determine the metes and bounds of the claims. Further, the Examiner notes that communications over the Internet inherently involve packets, as in TCP/IP.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title,

*if* the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerzberg et al. (US 6,452,923) in view of Official Notice.

As per claim 1, Gerzberg discloses return path management method(s) and system(s) for managing return paths from user televisions to provider systems (CATV, as in Fig. 1E and related text) in packetized form (the Internet, as in col. 1, lines 24-34);

As per claim 1, Gerzberg discloses a return path management system which delivers return paths from user televisions (Fig. 1E, CATV) to provider systems in a Packetized form,

comprising a return path server, a provider database, a user database and a content database (e.g., col. 33, lines 48-67),

wherein the provider database maintains providers information (col. 7, lines 8-26) depending on levels which the provider systems belong to and which determine service levels,

the user database maintains users information required for users authentication, a content database maintains contents information provided from the provider systems, and the return path server receives order information, identifies a provider to whom the received order information should be delivered, determines a service level based on the level which the provider belongs to in reference to the provider database, and performs interpretation and packetization of the order information depending on the determined service level.

As per claim 1, Gerzberg does not specifically disclose the number of servers and databases claimed. Official Notice is taken that the Internet is a network of multiple physical and logical servers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gerzberg and knowledge common to those of ordinary skill in the art to disclose, as per claim 1, a return path server, a provider database, a user database and a content database because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

As per claim 2, Gerzberg discloses the return path management system as set forth in claim 1, wherein the provider database maintains the providers information by categorizing each of the provider systems into any one of four levels based on the service level requested from the provider, and the return path server identifies the

provider and determines the service level referring to the received order information and the provider database, and then,

*if* the user's order is determined to be delivered to the provider system belonging to a first level, the return path server identifies an URL address of the provider system from the order information and delivers the received order information to the provider system in a Packetized form,

*if* the user's order is determined to be delivered to the provider system belonging to a second level, the return path server performs a user authentication referring to the order information and the user database, and delivers a user authentication information in combination with the received order information to the provider system in a Packetized form,

*if* the user's order is determined to be delivered to the provider system belonging to a third level, the return path server performs a user authentication referring to the order information and the user database, extracts a billing information (see, e.g., Fig. 31 and related text concerning billing features) from the order information (e.g., Fig. 2 and related text) to perform a billing processing in contact with a financial server as a representative of the provider (e.g., col. 11, lines 31-50), and delivers a user authentication information and a billing processing information in combination with the received order information to the provider system in a packetized form (e.g., via the Internet), or

*if* the user's order is determined to be delivered to the provider system belonging to a fourth level, the return path server performs a user authentication referring to the



order information and the user database, extracts a billing information from the order information to perform a billing processing in contact with a financial server as a representative of the provider, delivers a user authentication information and a billing processing information in combination with the received order information to the provider system in a Packetized form, and updates the content database referring to contents received from the provider system.

As per claim 3, Gerzberg discloses the return path management system as set forth in claim 2, containing service levels (e.g., Abstract)

*if* the user's order is determined to be delivered to the provider system belonging to a first level, a packetized communication delivered from the return path management system to the provider system contains a service level of the provider, a destination uniform resource locator (URL) of the provider system and an Encapsulated order information;

*if* the user's order is determined to be delivered to the provider system belonging to a second level, a packetized communication delivered from the return path management system to the provider system contains a service level of the provider, a destination URL of the provider system, a user identification information and an Encapsulated order information;

*if* the user's order is determined to be delivered to the provider system belonging to a third level, a packetized communication delivered from the return path management system to the provider system contains a service level of the provider, a destination URL of the provider system, a user identification information, a billing-processing

information and an Encapsulated order information (see, e.g., Fig. 31 and related text concerning billing features); and

*if* the user's order is determined to be delivered to the provider system belonging to a fourth level, a packetized communication delivered from the return path management system to the provider system contains a service level of the provider, a destination URL of the provider system, a user identification information, a billing-processing information, other order-related information and application-related information.

As per claim 4, Gerzberg discloses the return path management system as set forth in claim 1, wherein the return path management system has a hierarchy structure such that determination of the service level to the order information received from the user and processing of communication packets delivered from the return path management system to the provider system are separately performed (e.g., col. 2, line 58-col. 3, line5).

As per claim 5, Gerzberg does not specifically disclose the number of servers claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gerzberg and knowledge common to those of ordinary skill in the art to disclose, as per claim 5,

the return path management system as set forth in claim 4, comprising a return path server and four transaction servers coupled to the return path server wherein the return path server receives an order information from the user, identifies the provider system to which the order information is required to be delivered and determines the level to which the identified provider system belongs, referring to the provider system, and  
a first transaction server of the four transaction servers treats the order information to be delivered to the provider system belonging to a first level,  
a second transaction server of the four transaction servers treats the order information to be delivered to the provider system belonging to a second level in which a user authentication is performed referring to the user database,

a third transaction server of the four transaction servers treats the order information to be delivered to the provider system belonging to a third level in which a user authentication is performed referring to the user database and a billing processing is performed in contact with a financial server, and

a fourth transaction server of the four transaction servers treats the order information to be delivered to the provider system belonging to a fourth level in which a user authentication is performed referring to the user database, a billing processing is performed in contact with a financial server, and an update of contents is performed referring to the content database,

because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Claim 6 is rejected on the same grounds as claim 1.

Claim 7 is rejected on the same grounds as claim 2.

Claim 8 is rejected on the same grounds as claim 4.

Claim 9 is rejected on the same grounds as claim 5.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Levinson, US 7,222,358

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/  
James Zurita  
Primary Examiner  
Art Unit 3625